

REMARKS

In the present Application, Claims 12, 14, and 15 have been amended, and Claim 13 has been cancelled. As such, Claims 12 and 14-25 are currently pending.

The Examiner's rejections are as follows:

(I) Claims 12, 14-17, and 20-24 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Futami et al. (U.S. Pat., 4,740,245); and

(II) Claims 12 and 14-24 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Futami et al. ('245) in view of Futami et al. (U.S. Pat. 5,051,130).

Applicants note that the Examiner did not reject Claim 13 (which recites that the composition stimulates collagen regeneration). As detailed further below, Applicants have incorporated the limitations of Claim 13 into Claim 12 in order to advance the prosecution of this Application.

I-II. Claims 12 and 14-24 are Not Obvious

In the Final Office Action, the Examiner put forth two obviousness rejections. First, the Examiner rejected Claims 12 and 14-17 under 35 U.S.C. as being unpatentable over Futami et al. (U.S. Pat. 4,740,245; the '245 patent). The Examiner also rejected Claims 12 and 14-25 under 35 U.S.C. 103(a) as unpatentable over the '245 patent in view of U.S. Pat. 5,051,130 (the '130 patent). Applicants respectfully disagree with these rejections.

Both of the obviousness rejections are premised on the alleged teaching in the '245 and '130 patents of applying a composition to a "bone wound," with the Examiner asserting that a "bone wound" includes a root canal. The Examiner asserts that the scope of the claims are not limited to applying the composition to a bone, and therefore would include root canals. For example, the Examiner states:

"The rejected claim does not require application of a composition on or in a bone or bone structure. Rather, the recitation of claim 12 is directed to applying a composition to "a bone wound." According to the specification "a bone wound" includes a root canal or dental cavity." (*emphasis in original*, Office Action, pages 3-4);

and

"However, as reasoned above, Examiner ascertained the scope of the term "bone wound" to include dental injuries on tissues that lie on top of the bone, such as dental cavity or root canal. Nowhere does the claim exclude such injuries or limit the claim to application of the material on the bone or in the bone. (*emphasis added*, Office Action, page 4).

Applicants disagree with the Examiner's obviousness rejections and submit that no *prima facie* case of obviousness has been established (see previous Response dated 12-2-03).

Nonetheless, for business reasons, in order to further the prosecution of the present Application, yet without acquiescing to the Examiner's rejections, while explicitly reserving the right to prosecute the original claims (or similar claims) in the future, Applicants have amended the claims. In particular, Claim 12 has been amended to recite applying the composition on or in a bone as a dressing for a bone wound.¹ Support for this amendment is found in the Specification, for example, at page 3, lines 5-8. Claim 12 has also been amended to recite that the composition stimulates collagen regeneration in the bone. Support for this amendment is found in the Specification, for example, at page 2, lines 37-39 and page 4, lines 33-34.

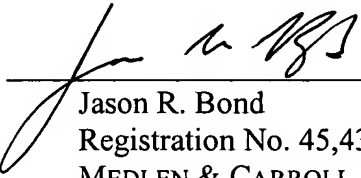
As the claims now recite applying a composition "on or in a bone" (as a dressing for a bone wound), the teaching of applying a mixture to a "root canal" in the '245 patent cited by the Examiner fails to teach this limitation (since a "root canal" is tissue, not bone). The claims have also been amended by incorporating the limitations of Claim 13 into Claim 12 such that Claim 12 now recites that the composition "stimulates collagen regeneration in said bone." As noted above, **the Examiner did not reject Claim 13**. Since all of the pending claims now include the limitations found in Claim 13, and the Examiner did not reject Claim 13, Applicants submit that all of the Claims should be passed to allowance. Moreover, the art cited by the Examiner (the '245 and '130 patents) does not teach applying a composition to a bone to "stimulate collagen regeneration." Consequently, Applicants submit that the Examiner would not be able to establish a *prima facie* case of obviousness in light of the cited art. Therefore, the amended Claims should be allowed.

¹ Applicants note that Claims 14 and 15 have also been amended to conform to the amendments of Claim 12 (i.e. by referring back to the "bone" now recited in Claim 12).

Conclusion

For the reasons set forth above, it is respectfully submitted that Applicants' claims should be passed to allowance. If the Examiner believes an Interview would help expedite the allowance of this case, Applicants ask the Examiner to call the undersigned at 608-218-6900.

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